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REMARKS

Claims 1, 4-5, 7, 10-11, 13, and 16-17 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Dickman, U.S. Patent No. 6,091,409, in view of Padawer, *et al*, U.S. Pub. No. 2002/0115476. In response, Applicants attach to this Response a Declaration pursuant to 37 CFR § 1.131 proving that the invention of this application was completed in the United States at a date prior to February 16, 2001, the effective date of Padawer. Because this invention was completed in the United States prior to the effective date of Padawer, Padawer is unavailable as a reference against this invention, and claims to this invention cannot be rejected under 35 U.S.C. § 103(a) on the basis of any combination that includes Padawer. Therefore, the rejection of all claims 1, 4-5, 7, 10-11, 13, and 16-17 should be withdrawn, and claims 1, 4-5, 7, 10-11, 13, and 16-17 should be allowed.

Claims 2-3, 6, 8-9, 12, 14-15, and 18 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Dickman, U.S. Patent No. 6,091,409, in view of Padawer, *et al*, U.S. Pub. No. 2002/0115476 and in further view of Rubin, *et al.*, U.S. Pub. No. 2004/0233235. In response, Applicants submit that Dickman, Padawer and Rubin are not available as a combination of references against the invention claimed in the present application because Padawer is unavailable as a reference against the invention of this application. Because this invention was completed in the United States prior to the effective date of Padawer, Padawer is unavailable as a reference against this invention, and claims to this invention cannot be rejected under 35 U.S.C. § 103(a) on the basis of any combination that includes Padawer. Therefore, the rejection of all claims 2-3, 6, 8-9, 12, 14-15, and 18 should be withdrawn, and claims 2-3, 6, 8-9, 12, 14-15, and 18 should be allowed.

Claims 1- 18 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-18.

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Claim Rejections – 35 U.S.C. § 103**Dickman And Padawer**

Claims 1, 4-5, 7, 10-11, 13, and 16-17 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Dickman, U.S. Patent No. 6,091,409, in view of Padawer, *et al*, U.S. Pub. No. 2002/0115476. Applicants respectfully traverse each rejection. As demonstrated above, Padawer is not a proper reference which may be cited against the present application. However, even if Padawer were a proper reference, the Office Action fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, certain basic criteria must be met. *Manual of Patent Examining Procedure* §2142. First, to establish a prima facie case of obviousness under 35 U.S.C §103, there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Second, to establish a prima facie case of obviousness under 35 U.S.C §103, the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Claims 1, 4-5, 7, 10-11, 13 and 16-17 stand rejected under 35 U.S.C. §103(a) as unpatentable over Dickman in view of Padawer. The proposed combination of Dickman and Padawer cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, and there is no suggestion or motivation to make the proposed combination.

**The Combination Of Dickman And Padawer Does Not
Teach All Of Applicants' Claim Limitations**

To establish a prima facie case of obviousness, the proposed combination of Dickman and Padawer must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Neither Dickman nor Padawer teach or suggest all of the limitations of Applicants' claims. The rejection should be withdrawn and claims 1, 4-5, 7, 10-11, 13 and 16-17 should be allowed.

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Independent claim 1 claims:

A context aware, shortcut enabled method of presenting information through a user interface on a client device, the method comprising the steps of:

selecting a context;

receiving a shortcut entered through the user interface, the shortcut having associated with it a shortcut field name set comprising one or more shortcut field names;

inferring from a context definition table, in dependence upon the context, a context table name and a context field name;

selecting information records from an information database in dependence upon the context, the context table name, the shortcut fields names, and the context field name; and

displaying selected records through the user interface on the client device.

**Dickman And Padawer Neither Disclose Nor
Suggest The Fourth Claim Element**

The Office Action admits that Dickman does not disclose the fourth element of claim 1, stating:

Dickman does not clearly teach the shortcut having a associated with it a shortcut field name set comprising one or more shortcut field names; and selecting information records from an information database in dependence upon the context, the context table name, the shortcut fields names, and the context field name

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The Office Action goes on to state that Padawer "teaches shortcut data store, shortcut name as a string, which can be displayed so that a user can . . . view (figs. 3 and 10, sections 0056-0058)." The Office Action appears to take the position that Padawer at Figure 3 and 10, sections 0056-0058 discloses the second element of claim 1 "the shortcut having associated with it a shortcut field name set comprising one or more shortcut field names," but fails to cite any portion of Padwar against the fourth element of claim 1. That is, no portion of the Office Action references any teaching or suggestion in Padawer of :

selecting information records from an information database in dependence upon the context, the context table name, the shortcut fields names, and the context field name

The cited portions of Padawer disclose a shortcut data store and several shortcut UIs. The shortcut data store and shortcut UIs of Padawer neither disclose nor suggest selecting information records from an information database in dependence upon the context, the context table name, the shortcut fields names, and the context field name as claimed in the present application. In fact, Padawer never even once mentions contexts, context table names, context field names, or selecting information records from an information database in dependence upon the context, the context table name, the shortcut fields names, and the context field name as claimed in claim 1. The combination of Padawar and Dickman do not disclose or suggest each and every element of claim 1 and the rejection should be withdrawn.

No Suggestion or Motivation to Combine Dickman and Padawar

To establish a prima facie case of obviousness, there must also be a suggestion or motivation to combine Dickman and Padawer. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine must come from the teaching of the cited references, and the Examiner must explicitly point to

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the teaching within references suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surka*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 3 states as its sole rationale for motivation to combine Dickman and Padawer as:

One having ordinary skill in the art would have found it motivated to utilize the use of selecting information records from a shortcut data store and shortcut field name (Padawer's section 0056-0058), into the system of Dickman for the purpose of reducing the number of steps to access desired information, thereby, helping the use of mobile devices more efficient (Padawer's Sections 0001 and 0006-0009).

Padawer at sections [0056]-[0058] does disclose a shortcut data store and a shortcut name. Padawer at section [0001] is a priority claim to an earlier provisional patent filing, suggesting nothing whatsoever about combining Dickman with Padawer. Additionally, Padawer at sections [0006]-[0009] merely describes in general terms: shortcuts in which the target information defines "content", shortcuts created with different types of tags, execution of shortcuts from one or more particular applications or no application, and creating a shortcut using a shortcut application or another application, suggesting nothing whatsoever about combining Dickman with Padawer. Without more, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. As such, there is no suggestion or motivation to combine Dickman with Padawer and, even if Padawer were a proper reference, which it is not, the proposed combination of Dickman with Padawer could not establish a prima facie case of obviousness.

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Dickman, Padawer And Rubin

Claims 2-3, 6, 8-9, 12, 14-15, and 18 stand rejected under 35 U.S.C. §103(a) as unpatentable over Dickman, U.S. Patent No. 6,091,409, in view of Padawer, *et al*, U.S. Pub. No. 2002/0115476 and in further view of Rubin, *et al.*, U.S. Pub. No. 2004/0233235. To establish a prima facie case of obviousness, the proposed combinations of the references must teach or suggest all of the claim limitations of claims 2-3, 6, 8-9, 12, 14-15, and 18. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claims 2-3, 6, 8-9, 12, 14-15, and 18 depend from claims 1, 4-5, 7, 10-11, 13 and 16-17, respectively, and include all of the limitations of the claims from which they depend. The rejection of the dependent claims 2-3, 6, 8-9, 12, 14-15, and 18 rely on the combination of Dickman and Padawer to teach each and every element of claims 1, 4-5, 7, 10-11, 13 and 16-17 from which they depend. As shown above, the combination of Dickman and Padawer in fact does not teach or suggest each and every element of claims 1, 4-5, 7, 10-11, 13 and 16-17. Because the combination of Dickman and Padawer does not teach or suggest each and every element of claims 1, 4-5, 7, 10-11, 13 and 16-17, the combination of Dickman, Padawer, and Rubin does not teach or suggest each and every element of the dependent claims 2-3, 6, 8-9, 12, 14-15, and 18. The proposed combination therefore does not teach or suggest each and every element of claims 2-3, 6, 8-9, 12, 14-15, and 18, and therefore, cannot establish a prima facie case of obviousness and the rejections should be withdrawn.

Conclusion

The rejection of all claims 1-18 should be withdrawn, and claims 1-18 should be allowed. Applicants respectfully traverse each rejection individually of claims 1-18 and request reconsideration of claims 1-18 in light of the present remarks.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447
for any fees required or overpaid.

Respectfully submitted,

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